

## **REMARKS**

Claims 2-6, 8-10 and 13-23 are now pending in this application. Claims 17-23 are independent. Claims 2-6, 8-10, and 13-18 have been amended, claims 19-23 have been added, and claims 1, 7, and 12 have been canceled by this Amendment. No new matter is involved with any claim amendment or new claim, as support may be found throughout the originally-filed disclosure, including the originally-filed claims.

### **Unpatentability Rejection over Henderson et al. in View of “E-Plus”**

Withdrawal of the rejection of claims 1-10 and 12-18 under 35 U.S.C. §103(a) as allegedly being unpatentable over Henderson et al (US 6,404,869) in view of “E-Plus” is requested. Independent claims 1, 7, and 12 have been canceled, thus rendering their rejection moot. Claims 1, 7, and 12 claims have been replaced by new claims 21-23, respectively, and to which the following comments pertain.

At the outset, Applicant notes that, to establish a *prima facie* case of obviousness, three basic criteria offer useful insights. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations.<sup>1</sup> Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.<sup>2</sup> The Supreme Court recently held that it is necessary, *inter alia*, for a court to look to interrelated teachings of multiple patents in order to determine whether there was an apparent reason to combine the known elements in the claimed. In this regard, the Court held “[t]o facilitate review, this analysis should be made explicit.”<sup>3</sup> “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”<sup>4</sup>

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<sup>1</sup> See MPEP §2143.

<sup>2</sup> *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and See MPEP §2143.

<sup>3</sup> *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_ (2007) (see p. 14).

<sup>4</sup> *See Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

### ***Discussion of Applicants' Disclosure***

By way of background, the present application relates to a method, network element, and system customizing prepaid service in a mobile telecommunication system in which different subscriber profiles having different attributes, and associating subscriber information with an indication of which profile to use with a particular subscriber. Service providers can then customize their prepaid service without changing the basic service structure by giving different profiles to the subscribers. By doing so, customizing and changing customized services becomes more easily implemented throughout the system.

By way of further background in response to the Examiner's specific request in the final office action, and as would be known to a person skilled in the art, an attribute is a qualitative feature (which may have a value, but a value is *not* an attribute), and a profile is a group of settings. One subscriber can have only one profile, but several subscribers can have the same profile (with the same attributes). Applicants' profile as variously claimed comprises at least an attribute that, in principle, defines an updating rule for a value in specifically maintained subscriber prepaid service information, wherein the value relates to the attribute.

### ***Discussion of Henderson et al.***

According to the abstract, Henderson et al. ("Henderson") is purportedly directed to a system and method for facilitating the use of a preferred discount rate pre-paid telephone calling card that includes a data storage system that stores data corresponding to a pre-paid telephone calling card and at least one location identifier related to the pre-paid telephone calling card. Location identifiers correspond to at least one telephone call service rate. The system and method also involve a pre-paid telephone calling card processing system that is coupled to the data storage system, and which is configured to receive location identifiers during a setup call over a telephone network. The location identifiers are stored in the data storage system during the set up call. During an access telephone call, such as one which an outbound telephone call may be made in accordance with a pre-paid telephone calling card to a terminating telephone number based on a location identifier, the calling party may realize preferred, discounted telephone service rates. Such rates may be used to bill calls against available call usage units, etc., based on a selected location identifier.

The Final Office Action appears to concede on page 3, lines 9-21 that Henderson fails to disclose, teach or suggest how the prepaid service is to be updated during recharge. In addition, Applicants continue to point out that there are additional recited features that are clearly absent in Henderson.

For example, and as acknowledged by the Office Action of January 11, 2006, Henderson does not disclose, teach or suggest associating **subscription information** with a prepaid account. (See, *e.g.*, page 3, lines 17-19 of the January 11th Office Action). As another example, and contrary to the Examiner's most recent assertions in the Final Office Action, Henderson does not disclose, teach or suggest defining at least two different profiles.

Further, even assuming that Henderson teaches or suggests card usage data and location identifiers corresponding to two different profiles, which it does not, Henderson still does not disclose the features of associating the prepaid subscriber's **subscriber information** with *only* one of the at least two different prepaid profiles.

Based on reasoning present throughout several Office Action's, each subscriber's subscriber information in Henderson **must always** be associated **with two different profiles**, because Henderson teaches that card usage data are associated with one location identifier to calculate the call charge. (See, *e.g.*, col. 5:54-56 and col. 6:44-47 of Henderson). However, such interpretation is contrary to the presently claimed invention, in which the subscriber's subscriber information are associated with one of the at least two prepaid profiles.

### ***Discussion of "E-Plus"***

On page 4 of the Final Office Action, the Examiner offers the "E-plus" brochure as allegedly making up for the deficiencies of Henderson, by asserting that "E-plus already teaches a customized method for prepaid service wherein at least two different prepaid profiles are offered to user [*sic*] which define how the prepaid services is updated during recharge".

However, what the "E-plus" brochure actually discloses is a prepaid service with attributes such as validity time and credit time window. However, there are no prepaid profiles disclosed, nor is it taught or suggested that pre-paid profiles may exist. For example, the validity time is clearly taught to depend on the amount of the recharge. Regarding the credit time

window, E-Plus only discloses that "the conditions stated in the tariff brochure of your service provider apply", thereby teaching that the credit time window depends on the prepaid service provider.

Furthermore, as would be known to a person of ordinary skill in the art, a prepaid service provider does not correspond to a prepaid profile. The brochure also teaches that a period during which a user can be contacted after the expiry of the credit time depends on a chosen tariff schedule. However, any such tariffs schedule is not a prepaid profile either. Further, the same tariffs schedule may be used to post-paid subscribers as well.

***Thus, the E-Plus brochure fails to teach a least two different prepaid profiles, the subscriber information indicating the prepaid profile which to use with the subscriber, and an attribute indicating how subscriber information is to be updated during recharge.***

Accordingly, E-Plus fails to remedy the previously discussed deficiencies of Henderson.

The Office Action alleges that E-Plus discloses at least two prepaid services and asserts that the motivation to make the combination of Henderson and E-Plus would be to "provide for a more flexible prepaid service that allows users more options to choose when recharging prepaid service." Applicants respectfully disagree with this unfounded assertion of motivation to combine the references in the manner suggested.

The alleged motivation, to "provide for a more flexible prepaid service that allows users more options to choose when recharging prepaid service", does not have any relevance either to the claims or to the combination of Henderson and E-Plus, and no evidence or rational reason is found in any of the references or, for that matter, in the Final Office Action, to support this conclusion. It is also not clear as to how a teaching that the account may be recharged with different amounts suggests that a subscriber's information is updated during the recharge. Furthermore, the claimed attribute is not selectable by the user at the time of the recharge.

To summarize, contrary to the Examiner's assertions, E-Plus at least fails to disclose, teach or suggest defining at least two different prepaid profiles, each prepaid profile defining at least one attribute for the prepaid service, the attribute indicating how the prepaid service is to be provided. As another example, E-Plus fails to disclose, teach or suggest an attribute indicating how a subscriber's information is to be updated during recharge.

### ***Specific Deficiencies of the Applied Art***

The applied art, either alone or in combination, does not disclose, teach or suggest a method that includes, *inter alia*, "maintaining at least two different prepaid profiles definitions, each prepaid profile comprising for the prepaid service at least one attribute defining how prepaid service information relating to the attribute is to be updated during recharge...the prepaid subscriber's subscriber information comprising prepaid service information ***and an indication of which one of the at least two different prepaid profiles is to be used with this subscriber***; and ***updating, in response to the prepaid subscriber recharging the prepaid subscriber's account, the prepaid service information in the prepaid subscriber's subscriber information as defined by the attribute in the prepaid profile indicated by the prepaid subscriber's subscriber information***", as recited in newly-presented independent claim 21, replacing canceled independent claim 1 (emphasis added).

Further, the applied art, either alone or in combination, does not disclose, teach or suggest a telecommunications system that includes, *inter alia*, "at least one database having subscriber information on at least one prepaid subscriber, a prepaid subscriber's subscriber information comprising subscriber-specifically maintained prepaid service information, wherein the system is arranged to maintain at least two different prepaid profiles, each prepaid profile comprising at least one attribute for the prepaid service, ***the at least one attribute defining how prepaid service information relating to the attribute is to be updated during recharge***...wherein the system is arranged to indicate, in the prepaid subscriber's subscriber information, which one of the at least two different prepaid profiles is to be used; and ***to update, in response to the prepaid subscriber recharging the prepaid subscriber's account, the prepaid subscriber's prepaid service information as indicated by the attribute defined in the prepaid profile indicated by the prepaid subscriber's subscriber information***", as recited in newly-presented independent claim 22, replacing canceled independent claim 7 (***emphasis*** added).

Further, the applied art, either alone or in combination, does not disclose, teach or suggest a network element that includes, *inter alia*, "a database containing at least two different prepaid profile definitions, each prepaid profile comprising, for the prepaid service, ***at least one attribute definition defining how subscriber-specifically maintained prepaid service information relating to the attribute is to be updated in a corresponding subscriber information during***

***recharge of a subscriber account***, a first way defined in a first prepaid profile providing different updated information than a second way defined in a second prepaid profile with the same given values, ***the prepaid profile definitions not being definitions for means of recharge***", as recited in newly-presented independent claim 23, replacing canceled independent claim 12 (***emphasis*** added).

Still further, the applied art, either alone or in combination, does not disclose, teach or suggest a network element that includes, *inter alia*, "a processor configured to have access to at least two different prepaid profile definitions, each prepaid profile comprising at least one attribute for the prepaid service, ***the attribute defining how prepaid service information relating to the attribute is to be updated during a recharge***...a prepaid subscriber's subscriber information comprising prepaid service information and an indication of which one of the at least two different prepaid profiles is to be used with this subscriber, ***and to update, during a prepaid subscriber's account recharge, the prepaid service information in the prepaid subscriber's subscriber information as defined by the attribute in the prepaid profile indicated by the prepaid subscriber's subscriber information, the attribute not being selectable by means of recharge***", as recited in previously-presented independent claim 17, as amended (***emphasis*** added).

Finally, the applied art, either alone or in combination, does not disclose, teach or suggest a network element that includes, *inter alia*, "...means for obtaining at least two different non-subscriber-specific prepaid profile definitions, each prepaid profile comprising at least one attribute for the prepaid service, ***the attribute indicating how the prepaid service information relating to the attribute is to be updated with the voucher information during a recharge***...and ***means for updating the subscriber information during the recharge according to a prepaid profile associated with the recharging prepaid subscriber's subscriber information***", as recited in independent claim 18, as amended (***emphasis*** added).

Accordingly, since the applied art does not teach or suggest all the claimed limitations, reconsideration and allowance of previously presented independent claims 17-18 and replacement independent claims 21-23 are respectfully requested. In addition, dependent claims 2-6, 8-10, and 13-16 variously and ultimately depend from these allowable independent claims, and are submitted as being allowable at least on that basis, without further recourse to the

patentable features recited therein. Various ones of the dependent claims have been amended to ensure proper antecedent basis in light of their dependency on newly-presented independent claims 21-23.

### **New Claims**

New independent claims 19-20 have been drafted to avoid the applied art, and to further define that which Applicants are entitled to claim. As discussed above, new claims 21-23 have been drafted to replace independent claims 1, 7, and 12, respectively, and are submitted as distinguishing over the art of record as discussed above with respect to the unpatentability rejection of the previously pending independent claims. Consideration and allowance of new claims 19-23 are respectfully requested.

### **Conclusion**

All rejections having been addressed, Applicant submits that each of pending claims 2-6, 8-10 and 13-23 in the present application is in immediate condition for allowance. An early indication of the same would be appreciated.

In the event the Examiner believes that an interview would be helpful in resolving any outstanding issues in this case, the Undersigned Attorney is available at the telephone number indicated below.

For any fees that are due, including fees for extensions of time and filing of the RCE, please charge Deposit Account Number 03-3975 from which the Undersigned Attorney is authorized to draw. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Due Date: August 21, 2007

Respectfully submitted,

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